

REMARKS

I. OFFICE ACTION SUMMARY

The "Office Action Summary" page indicated that the office action is responsive to the communication filed 2/2/2006, noted that claims 1-17 are pending, and indicated that claims 1-17 were subject to restriction.

II. FORMAL DRAWINGS ACCEPTANCE

The Office Action Summary does not acknowledge and indicate acceptance of the formal drawings submitted 2/2/2006. In the next USPTO communication, the examiner should check box 10 and indicate that the formal drawings submitted 2/2/2006 are accepted.

III. REQUIREMENT FOR RESTRICTION

The office action contains a requirement for the applicant to elect examination of one of two groups of claims.

This is an unusual situation because the restriction of claims 1-17 in the outstanding office action occurs after the claims 1-17 were allowed. See page 5 of the office action mailed on November 7, 2001, allowing these claims.

In the office action, the examiner states that:

2. Restriction to one of the following inventions is required under 35 USC 121:

I. Claims 1-7, drawn to a structure of optically effective diffractive elements, classified in class 235, subclass 492.

II. Claims 8-17, drawn to a scanner apparatus classified in class 235, subclass 435.

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as

claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it can be read/processed by a different means. The subcombination has separate utility such as scanner for differently structured scanning documents.

In response, the applicant provisionally elects, with traverse, group I.

The applicant traverses the restriction requirement for the following reasons.

First, the examiner has already examined and allowed claims 1-17. Therefore, there can be no burden in "examining" this application since the claims are already allowed. Restriction requires a "substantial burden" for propriety. As a result, there is no legitimate basis for restriction in this application. The restriction should be withdrawn and the application allowed.

Second, the examiner has not met his burden in showing the requirements for combination/subcombination restriction. Specifically, the examiner has not identified how any "different means" by which the subject matter defined by claim 1 "can be read/processed by a different means". And, the examiner has not identified any "differently structured scanning documents" than the structure defined by claim 1 that can be read by the subject matter defined by claim 8. In this regard, note that claim 8 is limited to "An apparatus for capacitive examination of documents with optically effective diffraction security elements" and claim 1 defines a "structure of optically effective diffraction security elements".

IV. CONCLUSION

This application is in condition for allowance, not restriction. Instead of withdrawing allowed claims, the examiner should allow this application.

Should the examiner have any questions, he is urged to contact the undersigned at 703-415-0012.

1/12/2007

/RichardNeifeld#35,299/

DATE

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ATTORNEY OF RECORD

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